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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/743,080

12/23/2003

Atsushi Tomokuni

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11/28/2008

OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C.  
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ALEXANDRIA, VA 22314

EXAMINER

CHANNAVAJJALA, LAKSHMI SARADA

ART UNIT

PAPER NUMBER

1611

NOTIFICATION DATE

DELIVERY MODE

11/28/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/743,080	<b>Applicant(s)</b> TOMOKUNI, ATSUSHI	
	<b>Examiner</b> Lakshmi S. Channavajjala	<b>Art Unit</b> 1611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 July 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7,9 and 11-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-7, 9 and 11-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4-5-08;7-16-08</u>  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

Receipt of amendment and response dated 07-16-08 is acknowledged.

Claims 1-7, 9 and 11-19 are pending in the instant application.

In response to the amendment, the following rejection of record has been withdrawn and the following new rejection has been applied:

#### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. Claims 1-7, 9 and 11-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,346,507 to Watanabe et al (Watanabe) in view of EP 103910 (EP submitted on PTO-1449 on 7-16-08).
2. Watanabe teaches a liquid crystal composition in the form of a bi- continuous type microemulsion (col. 6, L 63-67) in makeup removing (cleansing) compositions for skin and hair. Watanabe teach liquid crystal microemulsions comprising 10-60% of a nonionic surfactant, 1-50% of a water-soluble substance with a hydroxyl group, 1-70% of silicone oil, up to 10-60% water (col. 2), which meet the instant components B, D, A and E respectively of claim 1. The specific surfactants, oils, solvents with OH groups are all described in col. 3, L 10 through col. 4, L 5 of Watanabe.
3. The specific nonionic surfactants of Watanabe in col. 3, L 11-28, include those recited in instant claims 5 and 6 (ex: polyethylene glycol fatty acid ester).

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4. The water soluble solvents of Watanabe (col. 3, L 29-54) read on those of instant claim 9.

5. For the claimed oils, Watanabe teaches hydrocarbon oils such as isoparaffin of claims 3 and 4 and hence the viscosity of claim 2 is implicit. Watanabe also teaches other oils (col. 4, L 35-50).

6. The amounts or percentages of components A, B, D and E in claims 1, 11, 13, 15 and 16 overlap with those taught by Watanabe.

7. While Watanabe does not teach the exact HLB of the hydrophilic surfactants of claim 1, 5 and 12, Watanabe teaches the surfactants for forming a surfactant phase, as also required in the instant application. Besides the surfactants described as nonionic by Watanabe includes the same surfactants described and claimed. Accordingly, burden is shifted to applicants to show that the surfactants do not meet the claimed HLB values. Instant claim 17 does not recite any specific substrate, whereas Watanabe recognizes cleansing or makeup removing compositions impregnated on tissue paper (background section of Watanabe).

8. Watanabe fail to teach instant component C i.e., a lipophilic amphiphile. However, Hasebe teaches that the amphipathic ceramides impart good-emulsion and stability properties to the composition.

9. EP teaches topical skin care composition in the form of a stable isotropic emulsion comprising 9% to 89% petrolatum, 10% to 90% water, 5% to 25% glycerin, up to 10% emulsifiers etc (abstract) for delivering active agents and emollients (pages 7-8). EP teaches emollients and skin conditioning agents such as fatty acids, fatty alcohols

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(page 8, Last paragraph and further Example A and B on page 26) and reads on the instant amphiphilic surfactants of the instant claims.

10. It would have been obvious for one of an ordinary skill in the art at the time of the instant invention was made to the emollients such as the fatty alcohols or fatty acids (of EP), in the compositions of Watanabe because EP suggests the claimed fatty acids and fatty alcohols as emollients and conditioner for treating dry skin and providing a barrier protection. Further EP states that the delivery of emollients and conditioners is optimum with the isotropic emulsion containing the components such as petrolatum, water, glycerin, emulsifiers. One of an ordinary skill in the art would have expected both cleansing and conditioning of the skin with the fatty acids or fatty alcohols of EP in the cleansing compositions of Watanabe.

11. With respect to claimed ratio of the component D to the sum of components B and C being 1 or greater, all of the references are drawn to preparing emulsions in cleansing compositions and therefore optimizing the individual amounts of an emulsion without compromising the separation of phases would have been within the scope of a skilled artisan.

### ***Response to Arguments***

12. Applicant's arguments with respect to claims 1-7, 9 and 11-19 have been considered but are moot in view of the new ground(s) of rejection.

13. Applicants argue that Watanabe teaches a one-phase system of isotropic surfactant continuous phase is described (column 3, lines 4-8) and in spite of the description of an isotropic surfactant continuous phase, the reference fails to disclose 1-

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45 wt. % of a lipophilic amphiphile of a fatty alcohol, a fatty acid or a monoalkylphosphoric acid. However, Watanabe teaches that as one of the embodiments and the prior art teachings are not limited to preferred embodiments and should be considered as a whole. They argue that the claims have now been amended to delete nonionic surfactants having an HLB value of 8 or less from the list of lipophilic amphiphile component (C). As the reference fails to disclose the claimed component (C) the claimed invention is not rendered obvious by this reference. Applicants' arguments are not persuasive because instant combination is now based on a different combination of references.

***Information Disclosure Statement***

14. The information disclosure statement (IDS) submitted on 7-16-08 has been considered by the examiner, except for the JP reference 2000-256132 for lack of English language translation.

15. The information disclosure statement (IDS) submitted on 4-05-08 has been considered by the examiner.

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lakshmi S. Channavajjala whose telephone number is 571-272-0591. The examiner can normally be reached on 9.00 AM -5.30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila G. Landau can be reached on 571-272-0614. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Lakshmi S Channavajjala/  
Primary Examiner, Art Unit 1611  
November 23, 2008